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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 869,101	08 29 2002	Noritsugu Yamasaki	06501-082001	9852

75901 03 25 2003  
Janis K Fraser  
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EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED 03 25 2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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12

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s),           , whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-6 ☐ are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-6 ☐ are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Serial Code Serial Number) \_\_\_\_\_
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies must be submitted.

☒ Information Disclosure Statement (IDS) filed in accordance with PTO 1444. Report to be filed with the next communication.

## DETAILED ACTION

Claims 1-6 are pending in the application.

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,166,219 and over claims 1-16 of U.S. Patent No. 6,420,409. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and the claims of the patent differ only by generic description of the products. See, for example, claim 1 of each of the patents and especially, the first compound listed in claim 4 of patent '219 and the third compound listed in claim 15 of patent '409.

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in the treatment of, for example, diabetes, etc. Therefore, the instant claimed products would have been suggested to one skilled in the

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Yamasaki et al. {WO 99/00373}. Since the WO is in a non-English language, an English equivalent, U.S. Pat. 6,420,409, will be referred to hereinafter.

Yamasaki et al. disclose products embraced by the instant claimed

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamasaki et al. {WO 97/24334}. Since the WO is in a non-English language, an English equivalent, U.S. Pat. 6,166,219, will be referred to hereinafter

Yamasaki et al. disclose products embraced by the instant claimed invention. See, for example, Compound 165 in Figure 21 on Sheet 21 of 58; column 37, lines 65-67; and column 38, lines 1-24.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(e) as being

Sperl et al. disclose products embraced by the instant claimed invention. See, for example, Example 111 in column 40 and columns 4-5.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamasaki et al. {WO 99/00373}, Yamasaki et al. {WO 97/24334} and Sperl et al. {U.S. Pat. 6,348,032}, each taken alone or in combination with each other when similar utilities are asserted. As stated above, since each of the WO references is in a non-English

6,420,409 is in the same patent family as WO 99/00373 and U.S. Pat.

6,166,219 is in the same patent family as WO 97/24334.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim benzimidazole products. Yamasaki et al. '409 (columns 2, 3 and 16; or Compound 34 in Figure 6 on Sheet 6 of 22), Yamasaki et al. '219 (column 2, lines 10-47; column 37, lines 65-67; and column 38, lines 1-24; or Compound 165 in Figure 21 on Sheet 21 of 58) and Sperl et al. (columns 2-5 or Example 111 in column 40) each teach benzimidazole products which are either structurally the same as (see above 102 rejections) or structurally similar to the instant claimed products.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between some of the products of the prior art and the products instantly claimed is that of generic description.



*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., diabetic complications).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in the treatment of, for example, neoplasias, diabetes, etc. Therefore, the instant claimed products would have been suggested to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is unavailable, please contact the examiner's supervisor at (703) 308-1875.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

March 24, 2003